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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

<b>Proceeding</b>	92043074
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TRI/MARK CORPORATION,  Petitioner,  v.  HANSEN MANUFACTURING CO.,  Registrant.	Cancellation No. 92043074  Registration No. 2,275,109  Date Registered: September 7, 1999  Mark: Product design only
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**PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY  
JUDGMENT ON THE ISSUES OF MATERIAL ALTERATION AND TRADEMARK  
MUTILATION**

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## **I. INTRODUCTION**

On March 16, 2004, Petitioner, Tri/Mark Corporation ("Tri/Mark"), filed a Petition for Cancellation of Registration No. 2,275,109 ("the '109 registration") issued on September 7, 1999 for the trademark on a design on a vehicle handle assembly ("the alleged mark"), owned by Registrant, Hansen Manufacturing Co. ("Hansen"). On April 14, 2004, Tri/Mark filed a Motion for Summary Judgment on the issues of:

- material alteration of Hansen's alleged mark during prosecution; and
- mutilation of Hansen's alleged mark during prosecution.

On June 1, 2004, Hansen filed its opposition to Tri/Mark's summary judgment motion.

As set forth more fully below, Hansen's opposition attempts to mislead the Board in several respects: procedurally, legally and factually. Such attempts are made in an obvious effort to distract the Board from the actual merits of Tri/Mark's motion, and for good reason. More particularly, the undisputed evidence demonstrates that Hansen materially altered the original drawing and description of its alleged mark during prosecution of the application that issued as the '109 registration. The undisputed evidence further demonstrates that Hansen amended its alleged trademark during prosecution to seek registration on a "mutilated" version of the same. Tri/Mark's Motion for Summary Judgment should therefore be granted and the '109 registration canceled.

## **II. RELEVANT AND UNDISPUTED FACTS**

The first occurrence of inaccuracies in Hansen's Opposition occurs in its "Statement of Undisputed Facts." There, Hansen alleges that on April 25, 1996, it filed an application "that lead to the registration of the '109 Mark for 'a vehicle handle assembly for doors of emergency vehicles and fire trucks.'" This statement is misleading, however, since this is not an accurate

description of the design shown in the '109 registration, but instead describes the goods of the registration. More particularly, the design shown in the '109 registration is not "a vehicle handle assembly for doors of emergency vehicles and fire trucks," but instead consists only of "the substantially circular outer periphery of the flange of the vehicle handle assembly." (Hansen's Brief, Ex. A,<sup>1</sup> emphasis supplied.)

Hansen later states that in its response to the Examining Attorney's August 18, 1998 Office Action, it supplemented its evidence of acquired distinctiveness on November 19, 1998 with a copy of a court order and settlement agreement in a civil action between Hansen and a competitor "wherein the competitor conceded Hansen's protectible rights in its mark." (Hansen's Brief, p. 3, last paragraph.) This statement is incorrect. Instead, the settlement agreement states that Hansen's competitor, Eberhard, agreed to stop producing "'the' ring locks having a circular flange as depicted in Exhibit A" attached to the agreement. (See ¶ 2 of p. 3 of the Settlement Agreement, Ex. I to Tri/Mark's Initial Brief.)

Thus, under the terms of the settlement agreement, Eberhard did not concede that Hansen had protectible rights in the design shown in the '109 registration. Instead, Eberhard agreed not to sell goods having the entire design that Hansen originally applied for in the trademark application that eventually matured into the '109 registration, namely, the entire vehicle handle assembly including the "D" ring lock and circular flange.

Hansen does not argue that Tri/Mark's list of undisputed facts set forth in its initial brief is inaccurate. Further, Hansen does not allege that there are any facts that are in dispute for

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<sup>1</sup> All exhibits referenced were previously submitted with either Petitioner's Brief in Support of Its Motion for Summary Judgment on the Issues of Material Alternation and Trademark Mutilation ("Tri/Mark's Initial Brief") or Registrant's Response to Petitioner's Motion for Summary Judgment ("Hansen's Brief").

purposes of Tri/Mark's motion. Therefore, the Board can accept Tri/Mark's undisputed facts as true for purposes of making its summary judgment determination.

### **III. MATERIAL ALTERATION AND MUTILATION ARE PROPER GROUNDS FOR CANCELLATION**

Hansen argues that, "Tri/Mark's Motion for Summary Judgment must be denied as a matter of law because its material alteration and mutilation claims are not proper grounds for the cancellation of Hansen's registration." (Hansen's Brief, p. 4.) Hansen further asserts that, "[t]he TTAB has consistently held that issues not raised in an *ex parte* examination may not be raised in a subsequent *inter [partes]* proceeding." (Hansen's Brief, p. 4.) In doing so, Hansen completely misstates the applicable law.

In addition to standing, a plaintiff must also plead a statutory ground or grounds for opposition or cancellation. TBMP § 309.03(c). The TBMP notes that a plaintiff may raise any available statutory ground for opposition or cancellation that negates the defendant's right to registration.<sup>2</sup> *Id.* This specifically includes *ex parte* issues. *Id.*, n.116 citing *Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 223 U.S.P.Q. 909, n.10 (TTAB 1984) (Board cannot decline to consider an issue because it is *ex parte* in nature).

Even the cases cited by Hansen do not support its claim that material alteration and mutilation are inappropriate grounds for cancellation. First, Hansen cites the *Saint-Gobain* case whereby the Board held that, "the *ex parte* question of the sufficiency of the description of the mark is not a ground for opposition or cancellation." *Saint-Gobain Abrasives v. Unova Indus. Automation Sys., Inc.*, 66 U.S.P.Q.2d 1355, 1359 (TTAB 2003). However, the TTAB did not

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<sup>2</sup> For purposes of a cancellation proceeding, this assumes that the Principal Register registration is less than 5 years old. TBMP § 309.03(c).

state that *ex parte* examination issues per se are not proper for opposition or cancellation proceedings, which it could not have in view of the plain language of the TBMP. Instead, it appears the Board was making the distinction that formal "examination requirements," such as the description of the mark, are not proper grounds for opposition/cancellation proceedings, as opposed to a substantive underlying ground, "that negates the defendant's right to registration." TBMP § 309.03(c). Likewise, in *Phonak Holding AG v. ReSound GmbH*, 56 U.S.P.Q.2d 1057 (TTAB 2000), the Opposer's failure to submit a copy of the foreign registration, was an examination error and not a substantive issue that negated the Opposer's right to register.

Hansen also attempts to analogize the situation in *Marshal Field & Co. v. Mrs. Field's Cookies*, 11 U.S.P.Q.2d 1355 (TTAB 1989) with the circumstances of the present case. In the *Marshal Field* case, the TTAB held that the insufficiency of the specimens, *per se*, does not constitute grounds for cancellation. *Id.* at 1358. However, the TTAB allowed the plaintiff to amend its petition to instead allege that the term had not been properly used as a mark. *Id.* at 1359.

The situations set forth in the cases cited by Hansen are less similar to the grounds of material alteration and mutilation than those specifically listed in TBMP § 309.03(c) as examples of appropriate grounds for opposition or cancellation, which include:

- that defendant's mark is a mere background design that does not function as a mark separate and apart from the words displayed thereon; and
- that defendant's mark represents multiple marks in a single application (or registration) ("phantom mark").



In the above situations, the Defendant has attempted to improperly register either less than a whole mark or more than one mark. Likewise, in the present case, Hansen improperly registered a materially altered and mutilated version of its originally-applied-for design.

Hansen argues that "it would be manifestly unfair to penalize" it at this point for failing to address issues of material alteration and mutilation not raised by the Examiner since, had they been, Hansen would have had the opportunity to demonstrate that the amendments to its alleged mark as depicted and described were not material alterations, and did not result in a mutilation of its alleged mark. (Hansen's Brief, p. 5.) This argument is completely nonsensical. If Hansen would have truly been able to overcome a hypothetical rejection of its alleged mark on the basis of material alteration and/or mutilation by the Examining Attorney (as it claims), then where is the prejudice to Hansen to now have to meet this same burden before the Board? The simple fact is that Hansen got away with something during prosecution of the '109 registration, and the time has now come to pay the piper.<sup>3</sup>

#### **IV. HANSEN IS PROCEDURALLY ESTOPPED FROM RAISING A CLAIM OF IMPROPER GROUNDS FOR CANCELLATION**

Regardless of the merits of Hansen's claim that material alteration and mutilation are improper grounds for cancellation, Hansen is now estopped from making this argument. Section 503.01 of the TBMP provides that, when the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer. It is undisputed that Hansen did not file a motion to dismiss either before or concurrently with its answer.

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<sup>3</sup> Hansen asserts that since "Tri/Mark's material alteration and mutilation claims fail as a matter of law, the TTAB is permitted to enter summary judgment *sua sponte* in Hansen's favor," citing TBMP § 528.08 in support. Since TBMP § 528.08 only permits such a ruling in instances where there are no genuine issues of material fact, Hansen

Section 503.01 also provides that the defense of failure to state a claim upon which relief can be granted may be raised after an answer is filed, provided that it is raised by means other than a motion to dismiss, for example, by a motion for judgment on the pleadings, or by a motion for summary judgment. It is undisputed that Hansen has filed neither.<sup>4</sup>

In summary, Hansen cannot sit back and procedurally do nothing, hoping Tri/Mark's summary judgment claims will simply go away.<sup>5</sup>

**V. TRI/MARK HAS DEMONSTRATED A LACK OF GENUINE ISSUE OF MATERIAL FACT REGARDING THE ISSUES OF MATERIAL ALTERATION AND MUTILATION**

**A. Tri/Mark has Overcome any Presumption of Validity Afforded Hansen's Mark**

In its brief, Hansen argues that even if Tri/Mark's grounds for cancellation are valid, Tri/Mark has failed to provide sufficient evidence that Hansen materially altered or mutilated its mark. (Hansen's Brief, p. 6.) Hansen correctly notes that the registration of its alleged mark is *prima facie* evidence of its validity. However, evidence of the registration is not sufficient to avoid summary judgment if the evidence is rebutted or contradicted. *See, e.g., Tie Tech, Inc. v. Kinebyne Corp.*, 296 F.3d 778, 782 (9th Cir. 2002); *WSM, Inc. v. Hilton*, 724 F.2d 1320, 1326 (8th Cir. 1984) (presumption may be overcome by establishing generic nature of mark).

Although the ultimate burden of demonstrating validity remains with Hansen, and Hansen

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has again admitted that there are no genuine issues of material fact for purposes of the issues presented in Tri/Mark's motion.

<sup>4</sup> While Hansen had suggested to the Board that it could render summary judgment in its favor *sua sponte*, Hansen has not presented a formal cross-motion for summary judgment.

<sup>5</sup> Hansen's failure to follow proper procedures is also illustrated by its statement, in passing, that it is entitled to discovery on the issues of material alteration and mutilation, "in order to more fully respond to Tri/Mark's motion." (Hansen's Brief, p. 2, first paragraph.) Fed. R. Civ. P. 56(f) and TBMP § 528.06 allow a party to request discovery to oppose a motion for summary judgment by filing a request with the Board for time to take the needed discovery. However, TBMP § 528.06 requires the request to be "supported by an affidavit showing that the non-moving party cannot, for reasons stated therein, present by affidavit facts essential to justify its opposition to the motion." Hansen has presented no such affidavit, and its request must therefore be denied as a matter of law.

benefits from the presumption of validity, if Tri/Mark demonstrates through law, undisputed facts, or a combination that the mark is invalid (as it has done here), then "the evidentiary bubble bursts" and Hansen cannot survive summary judgment. *Tie Tech*, 296 F.3d at 793.

**B. Tri/Mark has Demonstrated there is no Genuine Issue of Material Fact on the Issue of Material Alteration**

Incredibly, in opposition to Tri/Mark's motion for summary judgment on the issue of material alteration, Hansen consistently states throughout its brief that it simply "disclaimed" the functional components of its alleged mark during prosecution, asserting that such disclaimers are not only routine practice during trademark prosecution, but in Hansen's case was actually required by the Examining Attorney. (*See, e.g.*, Hansen's Brief, p. 8.) This is a gross misstatement of the facts. Hansen did not merely disclaim the functional features of its alleged mark during prosecution. It completely deleted them!<sup>6</sup> (*See* Tri/Mark's Initial Brief, Ex. 1, p. 157; Ex. 5, p. 2.) As shown on pp. 4-5 of Tri/Mark's Initial Brief, Hansen initially amended its alleged mark to delete only the four mounting holes of the vehicle handle assembly. (Tri/Mark's Initial Brief, Ex. 1, Original Drawing, and Ex. 3, p. 2 and Substitute Drawing.) However, in response to a functionality rejection by the Examining Attorney, Hansen later deleted all of the features from its originally proposed mark except one, "the outer periphery having a circular shape." (Tri/Mark's Initial Brief, Ex. 5, p. 2.)

Hansen argues that Tri/Mark has not met its burden of proving that the design which Hansen eventually registered was "not unitary." (Hansen's Brief, p. 9, second paragraph.) Based on this argument, Hansen asserts that, "the functional elements of Hansen's mark were properly

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<sup>6</sup> Had Hansen actually disclaimed and not deleted the elements of its alleged mark as it asserts, such a disclaimer would have appeared in standardized format on the face of the '109 registration. TMEP § 1213.08(i).

disclaimed." (Hansen's Brief, p. 9, second paragraph.) Again, however, Hansen did not disclaim, but canceled all of these components from its mark. Moreover, since Hansen's entire argument against material alteration is based on this erroneous characterization of the prosecution of its application, Hansen has failed to "proffer countering evidence that show there is a genuine factual dispute for trial." TBMP § 528.01.

Hansen has not only mislead the Board with respect to the facts of this case, but also with respect to the standard for material alteration, which has nothing to do with whether or not a proposed mark is considered "unitary."<sup>7</sup> As noted in Tri/Mark's Initial Brief, the standard for material alteration is that the marks presented for registration, if amended during prosecution, must retain the same overall commercial impression. *In re CTB Inc.*, 52 U.S.P.Q.2d 1471, 1473 (TTAB 1999). Tri/Mark has certainly met its burden of proof for summary judgment under this standard. The deletion of all elements from the design of Hansen's proposed mark, save one, dramatically changed the commercial impression of Hansen's alleged mark from that which it originally proposed.<sup>8</sup> For all of these reasons, Tri/Mark's Motion for Summary Judgment on the Issue of Material Alteration should be granted.

**C. Tri/Mark has Demonstrated There is No Genuine Issue of Material Fact on the Issue of Mutilation**

Here again, Hansen alleges that it merely disclaimed portions of its alleged mark during prosecution in an attempt to refute Tri/Mark's motion for summary judgment. (Hansen's Brief, p. 11, first paragraph.) In this respect, Hansen asserts that disclaiming most of the design elements

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<sup>7</sup> As the Board is fully aware, whether components of a mark are considered "unitary" is the standard for determining whether certain elements of a mark must be disclaimed, which has no bearing here since Hansen deleted, not disclaimed, most of the elements of its alleged mark. TMEP § 1213.05.

<sup>8</sup> Hansen remarks on numerous occasions Tri/Mark's alleged failure to prove its claims by only pointing to evidence in the prosecution record for Hansen's registration. What Hansen wants the Board to forget is that the only evidence that is relevant to proving the claims of material alteration and mutilation is the prosecution history.

of its mark did not create a different or distinct commercial impression. (Hansen's Brief, p. 11, first paragraph.) Since Hansen's argument is based on an erroneous characterization of the facts, namely, that it disclaimed, not deleted most of the components of its alleged mark, its argument with respect to lack of mutilation fails as well.

Hansen also fails to argue the correct legal standard for mutilation. As noted in Tri/Mark's initial brief, the standard for mutilation is whether the drawing of matter shown in the trademark applicant's drawing constitutes a complete mark. TMEP § 807.14(b). If not, it is a "mutilation." *Id.* The determinative factor for mutilation is whether or not the subject matter in question makes a separate and distinct impression apart from the other element(s). TMEP § 807.14(b); *In re Chemical Dynamics, Inc.*, 839 F.2d 1569, 5 U.S.P.Q.2d 1828, 1829 (Fed. Cir. 1988).

Hansen argues that the cases cited by Tri/Mark for this mutilation standard do not apply to the circumstances of prosecution of the '109 registration on the basis that, "the deleted portions of the marks in each of Tri/Mark's cited cases were not registerable components, like those in Hansen's mark, but rather were registerable components that should not have been deleted, and therefore resulted in mutilation." (Hansen's Brief, p. 11.) Hansen's argument is not understood, however, since whether or not a deleted portion of a mark is "registerable" or "unregisterable" has no relevance or bearing on the mutilation determination.

As already demonstrated, during prosecution Hansen deleted (not disclaimed) all portions of its alleged mark but one: the outer periphery of the housing formed by a substantially circular flange. (Tri/Mark's Initial Brief, Ex. 1, p. 157.) Hansen's specimen, a photograph of its goods, and copies of its promotional catalogs submitted during prosecution of the '109 registration demonstrate that the outer circular flange of the vehicle handle assembly was never emphasized

separately to constitute a mark in and of itself, and therefore did not create a separate commercial impression from the vehicle handle assembly as a whole. (Tri/Mark's Initial Brief, Ex. 1, pp. 13, 27, 47-104.) Thus, Hansen's deletions to its originally-filed design during prosecution of the '109 registration, meets the mutilation standard.

## **VI. CONCLUSION**

For all of these reasons, Tri/Mark respectfully requests that its Motion for Summary Judgment be granted and the '109 registration canceled.

Respectfully submitted,

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**CERTIFICATE OF FILING**

I hereby declare that the attached **PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ON THE ISSUES OF MATERIAL ALTERATION AND TRADEMARK MUTILATION** has been filed via the Electronic System for Trademark Trials and Appeals (ESTTA) this 21st day of June, 2004.

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/Wendy K. Marsh/

**CERTIFICATE OF SERVICE**

I hereby declare that the foregoing instrument was served upon the following this 21st day of June, 2004, via:

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